

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: DEL FAVERO, JR. et al.

Title: METHOD AND SYSTEM FOR INFORMATION
RETRIEVAL BASED ON MENU SELECTIONS

Appl. No.: 10/006,930

Filing Date: 12/6/2001

Patent No.: 7,548,899

Grant Date: 6/16/2009

Examiner: Merilyn P. Nguyen

Art Unit: 2163

Confirmation 9296

Number:

**RENEWED REQUEST FOR RECONSIDERATION OF PATENT TERM
ADJUSTMENT UNDER 37 C.F.R. §1.705**

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants respectfully renew their request for reconsideration of the Patent Term Adjustment (PTA) determined for the captioned patent. The USPTO indicated in the letter mailed May 12, 2009 (copy attached), that a decision on the Applicants' initial request was being held in abeyance until after the actual patent date. As noted, the patent issued on June 16, 2009, as U.S. Patent No. 7,548,899.

The Patent Office determined that the patent was entitled to 227 days of PTA. Applicants believe that this PTA determination was made in accordance with the "Explanation of 37 CFR 1.703(f) and of the United States Patent and Trademark Office Interpretation of 35 U.S.C. §154(b)(2)(A)" published at 69 Fed. Reg. 34238 (Jun. 21, 2004). Under that interpretation of the PTA statute, any PTO delay under 35 U.S.C. § 154(b)(1)(A) is deemed to overlap with any 3-year maximum pendency delay under 35 U.S.C. § 154(b)(1)(B), and so, as a practical effect, PTA may be awarded under §154(b)(1)(A) or §154(b)(1)(B), but not both.

On September 30, 2008, the United States District Court for the District of Columbia issued a decision finding that the U.S. Patent and Trademark Office's interpretation of the PTA statute is incorrect. *Wyeth v. Dudas*, Civ. Action No. 07-1492 (JR) (Sep. 30, 2008). The court

determined that, under the correct interpretation of the PTA statute, periods of "overlap" are limited to "periods of time . . . [that] occur on the same day." *Wyeth*, slip op. at 8. Thus, a PTO delay under §154(b)(1)(A) overlaps with a delay under §154(b)(1)(B) only if the delays "occur on the same day." *Id.*

Applicants have recalculated PTA for the captioned patent under the court's interpretation of the PTA statute, and have determined that the patent is entitled to 482 days PTA, as shown on the attached sheet, which shows the relevant delays under 37 CFR §§1.702(a) and (b), and under 37 CFR §§1.703(a) and (b).

The attached sheet details the circumstances during the prosecution of the application resulting in the patent that constitute a failure to engage in reasonable efforts to conclude processing or examination of such application as set forth in § 1.704.

(a) Total of non-overlapping PTO delay under §154(b)(1)(A) & (B):	952 days
(b) Total Applicant delay:	470 days
Final PTA Determination:	482 days

Applicants therefore respectfully request that the patent be accorded 482 days PTA.

The patent is not subject to a terminal disclaimer.

Because this is a renewed request, Applicants do not believe that any fee is due, the fee having been paid with the Applicants' original request on January 8, 2009. However, if a fee is due, and should no proper payment be enclosed herewith, as by the credit card payment instructions in EFS-Web being incorrect or absent, resulting in a rejected or incorrect credit card transaction, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741.

Applicants request further that a decision on this request be deferred or delayed until a final decision has been rendered in *Wyeth v. Dudas*, which is now on appeal at the U.S. Court of Appeals for the Federal Circuit, under Federal Circuit Docket No. 2009-1120.

Respectfully submitted,

By 

Date July 14, 2009

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MAY 12 2009

OFFICE OF PETITIONS

In re Application of :
Del Favero et al. :
Application No. 10/006,930 : ON APPLICATION FOR
Filed: December 6, 2001 : PATENT TERM ADJUSTMENT
Atty Docket No. 088245-3074 :
:

This is in response to the REQUEST FOR RECONSIDERATION OF PATENT TERM ADJUSTMENT UNDER 37 C.F.R. §1.705 filed January 8, 2009. Applicants submit that the final patent term adjustment should be five hundred sixty-four (564) days. Referring to Wyeth v. Dudas, 580 F. Supp. 2d 138, 88 U.S.P.Q. 2d 1538 (D.D.C. 2008), applicants request this correction on the basis that the Office will take in excess of three years to issue this patent.

As the instant application for patent term adjustment requests reconsideration of the patent term adjustment as it relates to the Office's failure to issue the patent within 3 years of the filing date, a decision is being **held in abeyance** until after the actual patent date. Knowledge of the actual date the patent issues is required to calculate the amount, if any, of additional patent term patentee is entitled to for Office failure to issue the patent within 3 years. See § 1.703(b). (This is true even in this instance where a request for continued examination (RCE) was filed. The computer will not undertake the § 1.703(b) calculation until the actual date of issuance of the patent has been determined. Accordingly, it is still too soon to make a determination as to the correctness of any period of adjustment that will or will not be entered pursuant to § 1.703(b)).

MCW
PSH
CMA

RECEIVED

May 10 2009

NOTED *MCW*

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MADISON, WI
IP DOCKETING

Applicant is given TWO (2) MONTHS from the issue date of the patent to file a written request for reconsideration of the patent term adjustment for Office failure to issue the patent within 3 years. A copy of this decision should accompany the request. Applicant may seek such consideration without payment of an additional fee. However, as to all other bases for seeking reconsideration of the patent term adjustment indicated in the patent, all requirements of § 1.705(d) must be met. Requests for reconsideration on other bases must be timely filed and must include payment of the required fee.

Rather than file the request for reconsideration of Patent Term Adjustment at the time of the mailing of the notice of allowance, applicant is advised that they may wait until the time of the issuance of the patent and file a request for reconsideration of the patent term pursuant to 37 CFR 1.705(d). The USPTO notes that it does not calculate the amount of time earned pursuant to 37 CFR 1.702(b) until the time of the issuance of the patent and accordingly, the Office will consider any request for reconsideration of the patent term adjustment due to an error in the calculation of 37 CFR 1.702(b) to be timely if the request for reconsideration is filed within two months of the issuance of the patent.

It is acknowledged that any period of adjustment will be entered in light of 35 U.S.C. 154(B) GUARANTEE OF NO MORE THAN 3-YEAR APPLICATION PENDENCY, which provides that:

Subject to the limitations under paragraph (2), if the issue of an original patent is delayed due to the failure of the United States Patent and Trademark Office to issue a patent within 3 years after the actual filing date of the application in the United States, not including —

- (i) any time consumed by continued examination of the application requested by the applicant under section 132(b);

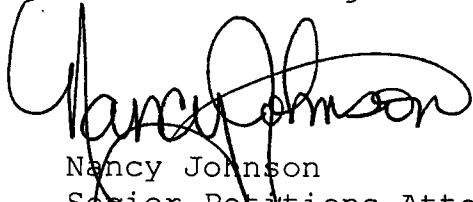
It is noted that a Request for Continued Examination (RCE) was filed in this application on May 6, 2008.

The determination of the patent term adjustment at the time of the mailing of the notice of allowance remains three hundred eight (308) days.

The Office acknowledges submission of the \$200.00 fee set forth in 37 CFR 1.18(e). No additional fees are required.

The application is being forwarded to the Office of Data Management for issuance of a patent. The patent term adjustment indicated on the patent (as shown on the Issue Notification mailed about three weeks prior to patent issuance) will include any additional adjustment accrued both for Office delay in issuing the patent more than four months after payment of the issue fee and satisfaction of all outstanding requirements, and for the Office taking in excess of three years to issue the patent (to the extent that the three-year period does not overlap with periods already accorded and is not consumed by the filing of a request for continued examination).

Telephone inquiries specific to this decision should be directed to the undersigned at (571) 272-3219.



Nancy Johnson
Senior Petitions Attorney
Office of Petitions

Patent Term Adjustment Calculation System

Add a new event to this case

Docket Number: 088245-3074
 Application Number: 10/006930
 Patent Number: N/A

	Event Description	Event Date	Days from Filing	PTO Days	Applicant Days
Edit Delete	Application Filing Date	12/06/2001	0		
Edit Delete	Notice to File Missing Parts	01/07/2002	32		
	Notice to File Missing Parts + 3 months	04/07/2002	122		
Edit Delete	Response to Notice to File Missing Parts	04/10/2002	125		3
	14 month From Application date	02/06/2003	427		
Edit Delete	Non-Final Office Action	06/17/2004	924	497	
	Non-Final Office Action + 3 months	09/17/2004	1,016		
	3 Year Period Starts	12/06/2004	1,096		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	12/21/2004	1,111		95
	Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo	04/21/2005	1,232		
Edit Delete	Final Office Action	05/05/2005	1,246	(14)	
	Final Office Action + 3 months	08/05/2005	1,338		
Edit Delete	Request For Continued Examination (including amendment)	09/02/2005	1,366	270	28
	3 Year Period Stopped	09/02/2005	1,366		
Edit Delete	Non-Final Office Action	09/23/2005	1,387		
	Non-Final Office Action + 3 months	12/23/2005	1,478		
Edit Delete	Petition to Revive App. Received at PTO	05/30/2006	1,636		
Edit Delete	Non-Final Office Action Rsp. Rcv'd at PTO	05/30/2006	1,636		158
	Petition to Revive App. Received at PTO + 4 months	09/30/2006	1,759		
	Non-Final Office Action Rsp. Rcv'd at PTO + 4 mo	09/30/2006	1,759		
Edit Delete	Petition to Revive App. Accepted	11/29/2006	1,819		
Edit Delete	Final Office Action	02/23/2007	1,905	146	
	Final Office Action + 3 months	05/23/2007	1,994		
Edit Delete	Request For Continued Examination (including amendment)	05/29/2007	2,000		6
Edit Delete	Non-Final Office Action	06/21/2007	2,023		
	Non-Final Office Action + 3 months	09/21/2007	2,115		

Edit	Delete	Non-Final Office Action Rsp. Rcv'd at PTO	11/19/2007	2,174	59
Edit	Delete	Final Office Action	02/06/2008	2,253	
Edit	Delete	Final Office Action	04/07/2008	2,314	
Edit	Delete	Advisory Action	05/01/2008	2,338	
Edit	Delete	Request For Continued Examination (including amendment)	05/06/2008	2,343	
Edit	Delete	Request For Continued Examination (including amendment)	05/06/2008	2,343	
Edit	Delete	Non-Final Office Action	05/30/2008	2,367	
Edit	Delete	Non-Final Office Action Rsp. Rcv'd at PTO	08/29/2008	2,458	
Edit	Delete	Notice of Allowance	10/16/2008	2,506	
Edit	Delete	Issue Fee Paid	01/08/2009	2,590	
Edit	Delete	Formal Drawings Post-Allowance Received at PTO	01/08/2009	2,590	
		Issue Fee Paid + 4 months	05/08/2009	2,710	
Edit	Delete	Formal Drawings Received at PTO + 4 months	05/08/2009	2,710	121
Edit	Delete	Patent Grant Date	06/16/2009	2,749	39
				Totals: 952	470
				PTA: 482	

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